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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,281	11/14/2003	James Castleman	109.0037	2030
27997 7590 12/17/2008 PRIEST & GOLDSTEIN PLLC 5015 SOUTHPARK DRIVE SUITE 230 DURHAM, NC 27713-7736				
EXAMINER				
LUBIN, VALERIE				
ART UNIT		PAPER NUMBER		
3626				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/714,281

**Applicant(s)**

CASTLEMAN ET AL.

**Examiner**

VALERIE LUBIN

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 5-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 5-19 are pending

For reference purposes, the document paper number is 20081204

### ***Claim Rejections - 35 USC § 101***

2. Claims 14-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Claims 14-18 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

4. Claim 19 is directed to software which is not a patent eligible statutory class.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debber Pre-Grant Pub. No. 2003/0144887 in view of Libman U.S. Patent No. 6,999,938.

7. With respect to claim 5, Debber recites a system comprising a risk data repository and a risk evaluator (§ 73). Debber does not specifically recite an insurance data repository, but Libman does (Col. 12 lines 45-52; col. 13 lines 35-40). It would have been obvious to one of ordinary skill in the art to combine the teachings of Debber and Libman to include an insurance data repository in order to facilitate storage and retrieval of insurance data.

Claims 14 and 19 are rejected under the analysis of claim 5, as they recite the method performed by the above system.

8. For claim 6, Libman discloses a package terms development module and insurance packages (Col. 20 lines 45-67; col. 21 lines 55-58; col. 14 lines 23-27). It would have been obvious to one of ordinary skill in the art to combine the teachings of Debber and Libman to

allow for terms development based on different criteria in order to develop and market packages that are suitable to potential customers.

Claims 15-17 are rejected under the analysis of claim 6.

9. Claim 7 is rejected, as Debber recites an operator interface module (§ 66).

Claim 8 is rejected under the analysis of claim 7.

10. For claim 9, Debber and Libman do not recite a package negotiation module; however, Examiner takes Official Notice that means for negotiating/accepting or committing to insurance products were old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art to include a means by which a consumer can negotiate a product in order for providers to be more competitive.

11. With respect to claim 10, Libman recites insurance packages (Col. 14, lines 23-27). A predictable result of Debber and Libman would be to provide as many types of insurance packages as possible to clients in order to offer them better more customized products to meet their needs at competitive prices (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Claim 11 is rejected under the analysis of claim 10.

12. Claim 12 is rejected, as Debber recites a data processing system (Abstract).

13. Claim 13 is rejected, as Debber recites the Internet (Abstract).

14. For claim 18, Debber discloses presenting a hypertext form and receiving a submission of information entered using the hypertext forms (§§ 92, 93, 96).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Luchs et al., U.S. Patent No. 4,831,526 discloses means for negotiating an insurance product as well as other of Applicant's limitations.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626